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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,097	07/23/2003	Paul James Taysom	6647-049	8954
45842 7590 02/18/2009 MARGER JOHNSON & MCCOLLOM, P.C. - NOVELL 210 SW MORRISON STREET SUITE 400 PORTLAND, OR 97204				
EXAMINER				
LY, CHEYNE D				
ART UNIT		PAPER NUMBER		
2168				
MAIL DATE		DELIVERY MODE		
02/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/626,097

Applicant(s)

TAYSOM, PAUL JAMES

Examiner

CHEYNE D. LY

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62, 68-70 and 72-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62, 68-70, and 72-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 16, 2008 has been entered.
2. The addition of claims 72-76 has been entered.
3. Claims 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62, 68-70, and 72-76 are examined on the merits.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62, 68-70, and 72-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
6. The last two lines of claim 17 recite "wherein the contract object is created and used without participation by a user, the first object, or the second object" which cause the claimed invention to be vague and indefinite. First, lines 5-7 of claim 17 recites

"determining a relationship between the first object and the second object; using the contract object to represent the relationship between the first object and the second object" which supports at least the first and second objects participate in the usage of the claimed contract object. Therefore, the last two lines seem to contradict the limitations recited in lines 5-7. Further, the specification further supports that the first object and the second object participate in the usage of the contract. For example, page 6, lines 9-10 recite file 115 (first object) and collection 205 (second object) have a list of associated contracts "allows both file 115 and collection 205 to locate contract 215, which establishes the relationship between file 115 and collection 205. Therefore, the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention..

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 17-24, 26-30, 32, 44-46, 48, 49, 54, 60-62, 68-70, and 72-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. The last two lines of claim 17 recite "wherein the contract object is created and used without participation by a user, the first object, or the second object" which cause the claimed invention to be vague and indefinite. First, lines 5-7 of claim 17 recites "determining a relationship between the first object and the second object; using the contract object to represent the relationship between the first object and the second object" which

supports at least the first and second objects participate in the usage of the claimed contract object. Therefore, the last two lines seem to contradict the limitations recited in lines 5-7 which causes the claim to be vague and indefinite.

10. Second, the specification further supports that the first object and the second object participate in the usage of the contract. For example, page 6, lines 9-10 recite file 115 (first object) and collection 205 (second object) have a list of associated contracts "allows both file 115 and collection 205 to locate contract 215, which establishes the relationship between file 115 and collection 205. Therefore, the specification does not resolve the vague and indefinite issue raised by the claim amendments.
11. The same issue is present in claim 44. Claims 18-24, 26-30, 32, 45, 46, 48, 49, 54, 60-62, 68-70, and 72-76, are rejected for being dependent from claim 17 or 44.

PRIOR ART

12. The subject matter encompassed by the claims must be reasonably understood without resort to speculation. Presently, speculation and conjecture must be utilized by us and by the artisan inasmuch as the claims do not adequately reflect what the disclosed invention is. Note In re Steele, 305 F.2d 859, 862 (CCPA 1962) (A prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language.); Note also In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

CONCLUSION

13. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the

USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

14. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo, can be reached on (571) 272-3642.

/Cheyne D Ly/
Primary Examiner, Art Unit 2168